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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,447	02/11/2004	Koji Taga	F-8142	4804
28107	7590	03/03/2005	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			LOPEZ, MICHELLE	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/777,447

Applicant(s)

TAGA, KOJI

Examiner

Michelle Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been received.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The following is a Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the other end of a connecting tube". There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated Rahm (5,954,142).

Rahm discloses an air intake and exhaust device for a pistol type air impact tool having at the end of its handle an intake port 13 and an exhaust port 14 for compressed air for operating an air motor, a silencing bellows tube 34 surrounding an air intake tube at the vicinity of 27 wherein

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the silencing bellows tube 34 and the air intake tube define an annular passage therebetween as an air exhaust passage.

With respect to claim 2, Rahm discloses wherein the air intake tube is connected by a hose adapter 23 to the end of a connecting tube 20 fitted at one end in the intake port formed at the end of the handle.

With respect to claim 3, Rahm discloses wherein the connecting tube 20 has an externally threaded portion 25 for connection with the intake port 13 at one end and an externally threaded portion 24 for connection with the hose adapter 23 at the other end.

With respect to claim 4, Rahm discloses wherein the silencing bellows tube 34 is attached to one end of a deflector cover 30 attached to the end of the handle with a packing (not shown numerically) disposed therebetween.

With respect to claim 5, Rahm discloses wherein the deflector cover 30 is attached by inserting it about the connecting tube 20 fitted in the handle, holding it against the packing at the end of the handle and bringing the hose adapter 23 into threaded engagement with the connecting tube 20.

4. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsieh (6,131,390).

Hsieh discloses an air intake and exhaust device for a pistol type air impact tool having at the end of its handle an intake port 36 and an exhaust port 37 for compressed air for operating an air motor, a silencing bellows tube 21 surrounding an air intake tube 19 wherein the silencing bellows tube 21 and the air intake tube 19 define an annular passage therebetween as an air exhaust passage.

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With respect to claim 2, Hsieh discloses wherein the air intake tube 19 is connected by a hose adapter 18 to the end of a connecting tube 48 fitted at one end in the intake port formed at the end of the handle.

With respect to claim 4, Hsieh discloses wherein the silencing bellows tube 21 is attached to one end of a deflector cover 15 attached to the end of the handle with a packing 43 disposed therebetween.

With respect to claim 5, Hsieh discloses wherein the deflector cover 15 is attached by inserting it about the connecting tube 48 fitted in the handle, holding it against the packing 43 at the end of the handle and bringing the hose adapter 18 into threaded engagement with the connecting tube.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Sterling (6,209,678).

Sterling discloses an air intake and exhaust device for a pistol type air impact tool having at the end of its handle an intake port 14 and an exhaust port 16 for compressed air for operating an air motor, a silencing bellows tube 34 surrounding an air intake tube 15 wherein the silencing bellows tube 34 and the air intake tube 15 define an annular passage therebetween as an air exhaust passage.

With respect to claim 2, Sterling discloses wherein the air intake tube 15 is connected by a hose adapter 82 to the end of a connecting tube 22 fitted at one end in the intake port formed at the end of the handle.

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With respect to claim 3, Sterling discloses wherein the connecting tube 22 has an externally threaded portion for connection with the intake port 14 at one end and an externally threaded portion for connection with the hose adapter 82 at the other end as shown in Fig. 5A.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh (6,131,390).

Hsieh discloses the invention substantially as claimed wherein the connecting tube 48 has a threaded portion via 45 for connection with the hose adapter at one end and a fitting portion for connection with the intake port at the other, but does disclose that the fitting portion has an externally threaded portion.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided externally threaded portions for the purpose of threadly connecting the connecting tube with the intake port at one end, instead of providing a fitting connection, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Taga'334 is cited to show related invention.

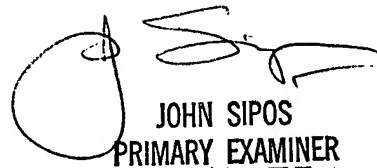
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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML



JOHN SIPOS  
PRIMARY EXAMINER